REMARKS

This is in response to the Final Office Action mailed January 25, 2005. Claims 1-12 are pending in the application. Claims 1, 2 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by CRAIG, U.S. Patent No. 4,003,265. Claims 3-11 are objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form. The subject matter of claims 1, 2 and 12 is not expressly or inherently disclosed by CRAIG as follows.

Rejected claims 1, 2 and 12 recite a method step of dynamically balancing a spindle assembly based upon a measured imbalance of a combination of the spindle assembly and eccentric rings. CRAIG discloses the steps of inserting or mounting balance rings on a rotating assembly and measuring an imbalance of the rotating assembly but does not expressly disclose mounting balance rings on the rotating assembly prior to measuring to balance the assembly based upon a measured imbalance of the combination claimed.

Absent an express teaching, anticipation of the claimed subject matter must be established by inherency. Inherency requires that those skilled in the art would recognize that the missing subject matter is present in the reference. *Continental Can Co. v Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

Claims 1, 2 and 12 were rejected on the basis that "[a] complete reading of CRAIG indicates that the rings are always mounted on the spindle". Office Action, Page 2, ¶ 4. Using this hypothesis, it appears that the Examiner reasons that **it is possible or probable** that the rings are mounted on the rotating assembly prior to measurement. "Inherency, however, may not be established by probabilities or possibilities. *Id* at 1269, 20 U.S.P.Q.2d at 1749.

CRAIG discloses steps for mounting or inserting balance

rings 36, 38, 60, 62 on a rotating assembly. The rings are **inserted** or mounted on the rotating assembly by "temporarily reduc[ing the] overall dimension" of each ring to insert the rings. (CRAIG Col. 4, lines 66-68). As shown, deformations 52 and 54 on the rings are used to reduce the dimension of the rings for insertion. Thus rings 36, 38, 60, and 62 are not always mounted on the rotatable assembly.

Rings 36, 38, 60 and 62 of CRAIG are mounted or "**inserted** such that . . . the rings assume[s] any one of a great number, actually an infinite number, of angular orientations . . . to introduce a mass balance which is equal in magnitude and opposite in direction to the mass balance of the system in the absence of the rings." (emphasis added) (CRAIG Col. 5, lines 26-31). "**[G]raduations** . . . are used when **inserting** the balance . . . rings to orientate the balance rings in such a position that a maximum mass balance effect is achieved". (emphasis added) (CRAIG Co. 6, lines 3-6).

"[A] dynamic balancer . . . is programmed to indicate the proper graduations which must be used when **inserting** the . . . rings 36, 38, 60, 62" (emphasis added)(CRAIG Col. 6, lines 1-4). Since the graduation is used **"when inserting"** the balance rings and the graduation is determined by measuring the mass imbalance, CRAIG inherently discloses that the mass imbalance is measured **prior** to inserting the balance rings. Thus CRAIG discloses that the "mass imbalance of the rotating system is measured in the absence of the balance rings 36, 38, 60, 62" contrary to the limitations of the claims. (CRAIG Col. 5, line 31).

Reliance on a probability or possibility that the imbalance could be measured with balance rings 36, 38, 60, 62 is contrary to the express or inherent disclosure of CRAIG and is not sufficient to establish a *prima facie* basis to reject the claims based upon inherency. Based upon the foregoing, allowance of claims 1, 2 and 12 is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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